

REMARKS

Applicant wishes to thank the Examiner for the attention accorded to the instant application.

Claims 1-3 are pending in the application. Applicant has amended claim 1.

Claim Rejections – 35 U.S.C. § 101

The Examiner has rejected claims 1-3 under 35 U.S.C. § 101 because claim 1 recites “a plurality of memories, each of which is for endless-recording” but memory is not able to store an unlimited amount of data. Applicant agrees that the amount of data stored in memory is not unlimited. However, “endless-recording” as defined in the specification on page 7, lines 14-17, means the conversation continues to be recorded, without stopping, until the conversation ends or a switch to another memory occurs. In the case where the memory is full, its contents are replaced, by recording new data over previously recorded data of the current conversation in that same memory. An endless amount of data is not stored, and the claims do not recite this.

Accordingly, both claims 1 and 2 recite the statutory subject matter of a plurality of memories for endless-recording (claim 1) and memory areas capable of endless-recording (claim 2), and applicant respectfully submits that claims 1 and 2 are patentable. Claim 3 depends from claim 1, incorporating all of the features and limitations of its base claim. Thus claim 3 is patentable for at least the reasons that claim 1 is patentable. Applicant requests that this rejection be withdrawn.

Claim Rejections – 35 U.S.C. § 112

The Examiner has rejected claims 1-3 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. This rejection should be withdrawn based on the comments and remarks herein.

Claim 1 is herein amended to recite that the “second memory endlessly records the audio data of the current conversation”. This amendment makes explicit what was implicit in the claim. Support for this amendment can be found on page 4, lines 4-6. Thus, claim 1 particularly points out and distinctly claims the subject matter of a second memory, which endlessly records (as defined above) the audio data of the current conversation. Claims 2 and 3 depend from claim 1, incorporating all of the features and limitations of this base claim. Thus claims 2 and 3 are patentable for at least the reasons that claim 1 is patentable. Withdrawal of this rejection is earnestly requested.

Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,732,349 to Sanpei et al. (hereinafter “Sanpei”) in view of U.S. Patent No. 6,658,496 to Minakata et al. (hereinafter “Minakata”), and further in view of U.S. Patent No. 6,222,909 to Qua et al. (hereinafter “Qua”). This rejection should be withdrawn based on the comments and remarks herein.

Among the problems recognized and solved by Applicant’s claimed invention is the need for a portable phone having a recording function by which a current conversation can be recorded and a portion reproduced while simultaneously recording the continuation of that current conversation. The invention is a portable phone having at least a plurality of memories, a switching unit and a reproducing unit. Upon initiation of a conversation on the inventive portable phone, a selected memory of the many memories automatically begins recording. The

conversation is endless-recorded; when the selected recording memory becomes full, the previously recorded data in this memory is replaced by new conversation data. When a user desires to preserve a conversation or portion thereof, he or she instructs the phone to begin recording in a second memory so that the data in the initially selected memory is saved and not replaced by new data. Recording in this second memory is also endless so that when this second memory is full, the conversation data overwrites the previously recorded data in that second memory. Further, a user can instruct the phone to reproduce or play back the contents of the initially selected memory while simultaneously continuing to record the current conversation in the second memory. Thus applicant's inventive apparatus is able to endless-record a current telephone conversation, and also play back a portion of the conversation while simultaneously endless-recording the remainder of the current conversation.

Sanpei discloses a portable telephone having a "memory means for storing speech during telephone conversation" (column 5, lines 1-4). The Examiner states that Sanpei discloses a portable phone comprising a memory which is for endless recording, as a conversation content, the audio data during the telephone conversation. Applicant respectfully disagrees. While the portable phone disclosed by Sanpei includes a memory, Sanpei does not teach or suggest that the memory is for endless-recording. Sanpei does not disclose what happens when the memory is full, and Applicant submits that at the time of Sanpei's invention, one skilled in the art would stop recording when the memory was full. By contrast, in the present invention, when the memory is full, the contents are updated so that the conversation continues to be recorded even though the initial portion of the conversation is overwritten. Thus Sanpei does not teach a memory or memory areas as recited in applicant's claims 1 and 2.

The Examiner states that Sanpei does not disclose or suggest a plurality of memories, each of which is for endless recording, as a conversation content, the audio data during the telephone conversation; a switching unit capable of switching said memories from a first memory of said memories to a second memory of said memories so that said second memory endlessly records the audio data of a current conversation instead of said first memory which endlessly records, as the conversation content, the audio data, until said switching unit switches said memories from said first memory to said second memory; and a reproducing unit for reproducing the conversation content which said first memory endlessly recorded before being switched by said switching unit, while the second memory endlessly records the audio data of the current conversation simultaneously with the reproducing of the conversation content from said first memory, but that Minakata discloses these features. Applicant respectfully disagrees that Minakata discloses these features.

Minakata discloses a plurality of memories, that is, a first flash memory and a detachable second flash memory (column 2, lines 64-66). However, the memories of Minakata are not for endless recording as described above. Instead, when the first memory of Minakata is full, data is written to the second memory (column 3, lines 39-42). Thus the memories of Minakata are distinguishable from the memories recited in the claims of the present invention.

Further, Minakata discloses a reproducing unit having a decoder for transducing speech data read out from the flash memory controlled by the controller, a filter for removing high-range components, and an amplifier (column 4, lines 47-50). The speech file is reproduced based on timing data from the table of contents (TOC) read out from the flash memory (column 5, lines 10-12, emphasis added). More exactly, the speech file is reproduced when the timing data or reproducing time stored in the RAM coincides with the timing information of the timer (column

5, lines 13-15). Minakata does not disclose or suggest switching recording from a first memory to a second memory to playback a portion of a current conversation from that first memory while simultaneously recording the remainder of that current conversation in the second memory. Thus, Minakata does not disclose or suggest “a reproducing unit for reproducing the conversation content which said first memory endlessly recorded before being switched by said switching unit, while the second memory endlessly records the audio data of the current conversation *simultaneously with the reproducing of the conversation content from said first memory*” as recited in claim 1.

Qua does not overcome this deficiency. Qua discloses an audio note taking system having a single storage device, and the system permits a user to record audio information from a wireless communication device for later distribution (column 1, lines 40-45 and column 4, lines 40-56, emphasis added). Qua does not teach a plurality of memories, as recited in claim 1 of the present application. In addition, Qua teaches only a single storage device and no switching unit, so that simultaneous recording of audio information while retrieval and playback of the previously recorded information occurs is impossible.

The Examiner further states that Minakata is from the same field of endeavor as Sanpei and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the portable telephone of Sanpei by specifically including a plurality of memories, a switching unit capable of switching memories and a reproducing unit as taught by Minakata. Applicant respectfully objects to this hypothetical combination of Sanpei and Minakata because Sanpei is addressed to a portable telephone while Minakata is addressed to a recording/reproducing apparatus, so that Minakata is not from the same field of endeavor as Sanpei.

It has been held that “[i]f a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection.” *In re Kahn*, 441 F.3d 977, 987 (Fed. Cir. 2006).

In the present application, an inventive solution to the problem of recording a current conversation while a previously recorded portion of the current conversation is simultaneously reproduced is disclosed and claimed (page 3, lines 21-23). A skilled artisan presented with this problem might first look to Sanpei for a possible solution since Sanpei discloses a “portable telephone for use in radio communications with a base station which is connected to a telephone network” (column 2, lines 55-57). As discussed above, Sanpei does not disclose or suggest all of the features of the present invention. One skilled in the art would not look to Minakata for a solution to the problem solved by the present invention. Minakata does not address the same purpose, nor does it relate to the same problem, as the present invention. Minakata discloses a recording/reproducing apparatus and addresses the problem of improving tractability of a recording/reproducing apparatus having plural storage units, such as removable storage units, and facilitating the operation of transfer processing for data stored in a storage unit of the recording/reproducing apparatus (column 1, lines 47-52). Minakata does not provide any suggestions or teachings regarding portable telephones, and, of more significance, does not discuss recording a current conversation at the same time as a previously recorded portion of that current conversation is reproduced. Thus a skilled artisan would not look to a recording/reproducing apparatus to facilitate the operating of transfer processing to solve the problem of the present invention which is to improve the recording function of a portable telephone such that conversation contents can be recorded and reproduced even during telephone conversation. Thus the Examiner has not established a *prima facie* case of obviousness.

As illustrated above, neither Sanpei nor Minakata nor Qua, taking singly or in any proper combination, teach or suggest all of the features of independent claim 1. Further, as discussed above, the combination of Sanpei and Minakata is not appropriate, and a *prima facie* case of obviousness has not been established. Therefore, Applicant respectfully submits that independent claim 1 is patentably distinguishable over the art of record in the application. Claims 2 and 3 depend from claim 1, incorporating all of the features of the base claim. Accordingly, claims 2 and 3 are patentably distinguishable over the art of record for at least the reasons, discussed above, that claim 1 is patentably distinguishable over the art of record. Withdrawal of this rejection is earnestly requested.

Conclusion

For the foregoing reasons, Applicant respectfully submits that all pending claims 1-3 are now in condition for allowance, and kindly solicits an early and favorable indication of allowability. If the Examiner has any reservation in allowing the claims, and believes a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully submitted,



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